

REMARKS

Reconsideration and allowance of the present application based the following remarks are respectfully requested.

Claims 53,55, and 61-66 are currently pending in the present application. Of these claims, claims 61-66 are newly added.

Independent claim 53 stands rejected under §103 as being obvious over JP 04-039090 to Mitsubishi Paper Mills (the Mitsubishi patent). Reconsideration of this rejection is requested based on the following distinguishing comments.

As set forth in M.P.E.P. §2143, to establish a *prima facie* case of obviousness, the Examiner must meet three basic criteria:

1. There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.
2. There must be a reasonable expectation of success.
3. The prior art reference (or references when combined) must teach or suggest all the claim limitations.

The Applicant submits that the Examiner has at least failed to establish a motivation or suggestion for modifying the Mitsubishi patent as asserted, and thus has failed to establish the first prong of the above obviousness test. Under the three-pronged obviousness test, the first prong requires the Examiner to establish that the prior art provides a teaching or suggestion to one of ordinary skill in the art to modify the cited reference to produce the claimed invention. See In re Fine,

In re Mabbott Application
Application No. 08/716,360

837 F.2d 1072 (Fed. Cir. 1988) (holding that Board of Patent Appeals & Interference erroneously upheld rejection of claims where prior art references failed to disclose a material limitation of the claims and that there was no evidence supporting the Board's assertion that the art showed a motivation or suggestion to combine references); see also M.P.E.P. §2143.03. It is not sufficient to simply cite a reference that is capable of being modified to establish the prima facie case of obviousness; instead the Examiner establish a motivation or suggestion to modify the reference as asserted. See In re Mills, 916 F2d 680 (Fed. Cir. 1990); see also, M.P.E.P. §2143.01. Further, the Examiner is required to cite evidence, either in the references themselves or in the knowledge generally available to one skilled in the art, to support his assertions underlying the prima facie case of obviousness. See In re Werner Kotzab, 217 F.3d 1365, 1371 (Fed. Cir. 2000). This applies to all the elements of the prima facie case of obviousness, including establishing a motivation or suggestion to modify a reference.

Claim 53 recites a material for transferring an image onto a substrate. The material of claim 1 comprises “a carrier providing a surface onto which an image can be created or onto which a preliminary transfer of an image can be made[.]” The surface is “provided by a layer or coating of polymethylpentene material on a backing sheet, the layer or coating being applied at a substantially uniform thickness” and at “a weight in the range of about 10 grams/m² to about 30 grams/ m².” The backing sheet is “paper of a weight in the range of 90 grams/m² to 110 grams/ m².” These limitations concerning the weight of the polymethylpentene (PMP) and the paper were added in the last amendment to more clearly distinguish claim 53 from the disclosure of the Mitsubishi patent.

In the outstanding Official Action, the Examiner correctly acknowledged that the Mitsubishi patent discloses a paper with a layer of PMP resin thereon, but fails to disclose the claimed weight ranges for the PMP layer and the paper. However, the Examiner asserted that the claimed weight ranges were merely an "experimental modification" of the Mitsubishi patent. Specifically, the Examiner stated that "the experimental modification of [the Mitsubishi patent] in order to ascertain optimum operating conditions fails to render applicants' claim patentable in the absence of unexpected results." The rationale apparently relied upon by the Examiner for asserting such a modification would be obvious is that basis weight (which is assumed to be the paper weight) can be modified to prevent curling and for receipt of an image receiving layer; and that coating weight can be modified to provide for proper coverage of the paper and to ensure that the paper fits in the printing mechanism.

The Examiner's rejection clearly lacks any evidence suggesting the specific weights recited in claim 53. While it is acknowledged that paper weight and coating weight can be modified to meet certain parameters, the Examiner has failed to produce any evidence into the record that suggests the claimed coating and paper weights. The mere fact that a prior art reference can be modified is not sufficient to establish the *prima facie* case of obviousness. See In re Mills, 916 F.2d 680, 682 (Fed. Cir. 1990)(stating that although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so."). In the present case, all that the Examiner has established is that the coating and paper weight in the Mitsubishi patent is capable of being modified, and that it is known to modify coating and paper weights.

However, the Examiner has not provided any evidence that provides a motivation or suggestion to modify the paper and coating weights as specified by claim 53. Therefore, it is respectfully submitted that the Examiner has failed to properly establish the prima facie case of obviousness.

It is noted that the Examiner indicated that “unexpected results” are required to overcome his prima facie case of obviousness. As an initial matter, the Examiner should note that unexpected results are a secondary factor in determining obviousness and are generally presented to rebut a properly established prima facie case of obviousness. If the prima facie case of obviousness is lacking, then there is no need for the Applicant to submit rebuttal evidence of non-obviousness, such as unexpected results. See M.P.E.P. §2142. Thus, the fact that the Examiner believes there is no evidence of unexpected results in the record should be of no consequence in view of the fact that the prima facie case of obviousness is lacking for the reasons advanced above.

Having clarified the procedural context for considering evidence of unexpected results, it is submitted that the specification itself provides ample evidence of unexpected results. Under the Examiner’s rationale modifying the Mitsubishi patent, the “expected” result of modifying the paper weight would be that curling is avoided and that the substrate would hold an image-receiving layer; and the “expected” result of modifying the coating weight would be that the paper is properly covered and would fit into a printing mechanism. However, the Examiner has not asserted, nor has he provided evidence, that one skilled in the art would “expect” the results achieved by the invention defined by claim 53. Specifically, page 7 of the specification states that “it has now been discovered that the use of a

material comprising [PMP] not only allows the problem of distortion to be overcome but also allows transfer of full colour images to be effected directly or indirectly from a photocopier or printer onto any desired suitable surface." Also, page 12 of the specification states:

The use of PMP material permits complete transfer of the toner from its initial carrier onto many other surfaces including of [sic] paper, card, cardboard, all of which may be uncoated or coated with many different types of finish, and of glass, ceramics, woods, metals (including aluminum, brass, tin, steel and iron), metallised surfaces, plastics materials (e.g. polypropylenes, PVC's, polyesters, acrylic materials, polyethylenes) and film form materials, and leathers, fabrics and textile materials.

The specification indicates that the known art does not provide a suitable medium that can be used in a printer or copier for the transfer of full color images to a target substrate, and yet the claimed invention is capable of meeting this need. Nothing in the art suggests that the claimed use of PMP in conjunction with the specified paper and coating weights would achieve this result. Thus, it is submitted that this result is indeed "unexpected" relative to the known art and is not merely an "advantage which would flow naturally from following the suggestion of the prior art[.]"

Based on the foregoing, it is submitted that the outstanding obviousness rejection against claim 53 has been overcome and withdrawal of that rejection is respectfully requested.

Claims 55 and 60 depend from claim 53 and are submitted to distinguish from the art of record for at least the reasons advanced above with respect to claim 53, and for the additional reason that they each recite additionally patentable features.

In re Mabbott Application
Application No. 08/716,360

New claims 61-66 are added and are believed to distinguish over the art of record for at least the reasons advanced above.

Filed herewith is an Information Disclosure Statement and a PTO-1449 listing the cited references. The Examiner is requested to consider these references, even though the application is after final, as they only list those references that were mentioned in the background section of the application or that were cited during the prosecution of the parent PCT application. These references were clearly available for the Examiner's consideration during prosecution, and this IDS is being submitted simply to make the record clear that they were indeed considered. It should be noted that UK Application 2,273,466 is the published version of UK Application 9325904.2 mentioned in the specification, and that U.S. Patent Nos. 5,542,096 and 6,198,898 are the U.S. counterparts of the same.

Additionally, documentation establishing Xyron U.K. Ltd. as the assignee of the present application and Pillsbury Winthrop LLP as the attorneys of record as being submitted herewith. The Examiner is asked to ensure that all correspondence and communications be directed to Pillsbury Winthrop LLP, and specifically to the undersigned, to avoid any delays in prosecution.

All objections and rejections having been addressed, it is respectfully submitted that the present application is in a condition for allowance and a Notice to that effect is earnestly requested.

In re Mabbott Application
Application No. 08/716,360

If the Examiner has any questions concerning this response, or the application in general, he is encouraged to contact the undersigned at the below-listed phone number to help facilitate prosecution of this application.

Respectfully submitted,

PILLSBURY WINTHROP LLP

By: 

Bryan P. Collins
Reg. No. 43,560
Tel. No.: 703.905.2038
Fax No.: 703.905.2500

1600 Tysons Boulevard
McLean, Virginia 22102
703.905.2000

APPENDIX

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Claims 61-66 are newly added claims.